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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,404	09/12/2000	Ejler L. Sorensen	1137U101	6670

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07/01/2003

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CANADA

EXAMINER

PARADISO, JOHN ROGER

ART UNIT	PAPER NUMBER
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3721

11

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/660,404

Applicant(s)

SORENSEN, EJLER L. Cn

Examiner

John R. Paradiso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 5-9 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-15 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. In the previous Office Action, certain elements of the rejection were not clearly explained. Accordingly, this Office Action supercedes the previous Office Action and is non-final.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10-15 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over GOLDBERG ET AL (US 5186515).

GOLDBERG ET AL discloses a gripper with a first clamp bar (12) connected to a first shaft (44) and a second clamp bar (20) connected to a second shaft (46). The first shaft goes through a bearing opening in the second clamp bar and, likewise, the second shaft goes through a bearing opening in the first clamp bar. Each shaft is also connected to a side of frame (26). The motor (42) causes the first and second shaft to move the clamp bars toward and away from each other as desired. Note that figure 1 of GOLDBERG ET AL does not show the label for (12), but

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it is clear from the disclosure in GOLDBERG ET AL that the "first clamp bar (12)" of GOLDBERG ET AL comprises first support bar (14) and first surface bar (16).

GOLDBERG ET AL does not disclose a plurality of clamp bar pairs or a plurality of first/second shaft pairs.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide for multiple shafts in order to increase the gripping power of the clamp bars, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Examiner notes that the preambles to the each claim recites "Carton gripper apparatus for gripping groups of cartons. While GOLDBERG ET AL is not specifically directed to gripping groups of cartons, it does meet all the structural requirements of the claim. MPEP 2115 address this issue and is quoted here for your convenience:

**MATERIAL OR ARTICLE WORKED UPON DOES NOT LIMIT APPARATUS CLAIMS**

"Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

In *In re Young*, a claim to a machine for making concrete beams included a limitation to the concrete reinforced members made by the machine as well as the structural elements of the machine itself. The court held that the inclusion of the article formed within the body of the claim did not, without more, make the claim patentable.

In *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967), an apparatus claim recited "[a] taping machine comprising a supporting structure, a brush attached to said supporting structure, said brush being formed with projecting bristles which terminate in free ends to collectively define a surface to which adhesive tape will detachably adhere, and means for providing relative motion between said brush and said supporting structure while said adhesive tape is adhered to said surface." An obviousness rejection was made over a reference to Kienzle which taught a machine for perforating sheets. The court upheld the rejection stating that "the references in claim 1 to adhesive tape handling do

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not expressly or impliedly require any particular structure in addition to that of Kienzle.” The perforating device had the structure of the taping device as claimed, the difference was in the use of the device, and “the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”

*Response to Arguments*

4. Applicant’s arguments filed 3/12/2003 have been fully considered but they are not persuasive.

5. Applicant states on page 7 of his Response that “In BIRK the cartons are lowered down, by a cylinder, into a case located below the station. They are not transferred sideways, from side to side.”

Applicant also states on page 7 of his Response that “In Birk there is only one packing station. It is located beneath the transfer station. Applicant has two packing stations. They are located on either side of the transfer station.”

However, the elected claims 10-15 are drawn to an apparatus for gripping and the details of the gripper itself. The claims do not recite method or means for lowering cartons into a case or the details of any packing stations, so the arguments are moot.

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6. Applicant states on page 7 of his Response that "There is no sliding action between claim bars and rods in the reference. The clamps 14 and 20 are both somehow fastened to the screw threaded rods 44 and 46. .. The clamps cannot slide on the rods."

However, as described in the previous Office Action:

GOLDBERG ET AL discloses a gripper with a first clamp bar (12) connected to a first shaft (44) and a second clamp bar (20) connected to a second shaft (46). The first shaft goes through a bearing opening in the second clamp bar and, likewise, the second shaft goes through a bearing opening in the first clamp bar. The motor (42) causes the first and second shaft to move the clamp bars toward and away from each other as desired.

When the shafts (44, 46) are rotated, they move slidably through the bearing openings, as described above.

7. Applicant states on page 8 of his Response that "There is nothing to show the rods [of GOLDBERG ET AL] how the rods could be rotated, in any case. There is nothing showing any connection between the motor 42 and the threaded rods 44 and 46."

However, while Applicant may desire more detail in the published patent to GOLDBERG ET AL for a complete understanding of the subject matter, GOLDBERG ET AL does clearly describe that the motor (42) causes the first and second shaft to move the clamp bars toward and away from each other as desired (see GOLDBERG ET AL column 2 line 59 to column 3 line 3).

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8. Applicant states on page 8 of his Response that "GOLDBERG is a totally inadequate document, and lacks any clarity. For example the text refers to element 12 [first clamp bar]. There is no numeral 12 in the drawings. Where and what is element 12. We do not know."

Examiner acknowledges the missing numeral 12 from the drawings of GOLDBERG ET AL and apologizes for the confusion. However, it is clear from the disclosure in GOLDBERG ET AL and from the description of the subject matter in paragraph 3 of the previous Office Action that the "first clamp bar (12)" of GOLDBERG ET AL comprises first support bar (14) and first surface bar (16)."

#### *Reference Citations*

9. The following prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:

- ZOETEN discloses an apparatus including shafts that slide through moving parts.
- PESSINA ET AL discloses a gripper in which shafts move slidably through alternate gripping plates (10, 11).


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***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center receptionist.

  
Examiner John Paradiso: (703) 308-2825

June 25, 2003

Additional Phone Numbers

Supervisor Rinaldi Rada: (703) 308-2187  
Receptionist: (703) 308-1148  
Customer Service: (703) 306-5648

Fax (Direct to Examiner): (703) 746-3253  
Fax (TC 3700 Official): (703) 872-9302  
Fax (TC 3700 After Final): (703) 872-9303